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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,671	03/17/2004	Chunhua Yan	CL000758DIV III	4101
25748	7590	04/05/2005	EXAMINER	
CELERA GENOMICS ATTN: WAYNE MONTGOMERY, VICE PRES, INTEL PROPERTY 45 WEST GUDE DRIVE C2-4#20 ROCKVILLE, MD 20850			MONSHIPOURI, MARYAM	
		ART UNIT	PAPER NUMBER	
		1652		
DATE MAILED: 04/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/801,671	YAN ET AL.
Examiner	Art Unit	
Maryam Monshipouri	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 24-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 24-37 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: attachment

Applicant's response to restriction requirement filed 10/7/2004 but scanned in on 3/7/2005 is acknowledged. Applicant elected Group III invention (claims 4-6, 8-11 and 22-23) without traverse. Claims 1-23 are canceled.

## **DETAILED ACTION**

Claims 24-37 are under examination on the merits.

### ***Priority***

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-26, and 30-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Nayler et al. (Biochem. J., 326, 693-700, 1997). Nayler teaches an isolated DNA encoding a product having at least 93.8% identity to SEQ ID NO:2 of this invention (see the attached sequence alignment). Since said percentage identity is very

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close to 95% it is believed that by changing the analysis parameters for sequence alignment Nayler's sequence can be displayed to encode a polypeptide having 95% identity to SEQ ID NO:2 of this invention and hence is capable of anticipating claims 25-26.

In pages 694-695 Nayler teaches cloning and expression of its sequence which involves preparation of vectors and host cells comprising said DNA sequence anticipating claims 30-37 of this invention.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25-26 and 30-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Ullrich (US20020106771, Aug 8, 2002). Ullrich teaches an isolated DNA sequence encoding a polypeptide having 93.8% identity to SEQ ID NO:2 of this invention (see the attached alignment). As stated above, since said percentage identity is very close to 95% it is believed that by changing the analysis parameters for sequence alignment Ullrich's sequence can be displayed to encode a polypeptide having 95% identity to SEQ ID NO:2 of this invention and hence is capable of anticipating claims 25-26.

In pages 4-5 Ullrich teaches about hosts and vectors comprising its DNA sequence and methods of expressing said DNA sequence anticipating claims 30-37 of this invention.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24-37 are rejected under the judicially created doctrine of double patenting over claims 1-9 of U. S. Patent No. 6,455,291 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the scope of currently pending claims embraces the scope of the claims in said issued patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

**No claims are allowed.**

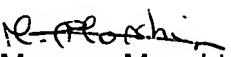
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (571) 272-0932. The examiner can normally be reached on 7:00 a.m to 4:30 p.m. except for alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnanthapu Achutamurthy can be reached on (571) 272-0928. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306 or (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Maryam Monshipouri Ph.D.

Primary Examiner

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RESULT 9

Qy 439 FDLLKK 445  
Db 421 FDLLKK 427

US-10-801-671-4  
; Sequence 4, Application US/10801671  
; Publication No. US20040152123A1  
; GENERAL INFORMATION:  
; APPLICANT: YAN, Chunhua et al.  
; TITLE OF INVENTION: ISOLATED HUMAN KINASE PROTEINS, NUCLEAR  
; ACID MOLECULES ENCODING HUMAN KINASE PROTEINS, AND USES  
; TITLE OF INVENTION: THEREOF  
; FILE REFERENCE: CLO0075BDIV-III  
; CURRENT APPLICATION NUMBER: US/10/801,671  
; CURRENT FILING DATE: 2004-03-17  
; PRIOR APPLICATION NUMBER: 60/227,470  
; PRIOR FILING DATE: 2000-08-24  
; PRIOR APPLICATION NUMBER: 09/810,671  
; NUMBER OF SEQ ID NOS: 5  
; SOFTWARE: FastSeq for Windows Version 4.0  
; SEQ ID NO: 4

Query Match 95.9%; Score 2312; DB 16; Length 427;  
Best Local Similarity 100.0%; Pred. No. 5.8e-170;  
Matches 427; Conservative 0; Nimatches 0; Gaps 0;  
Length: 427  
; TYPE: PRT  
; ORGANISM: Homo sapiens  
; SEQ ID NO: 4

US-10-801-671-4

Query Match 95.9%; Score 2312; DB 16; Length 427;  
Best Local Similarity 100.0%; Pred. No. 5.8e-170;  
Matches 427; Conservative 0; Nimatches 0; Gaps 0;  
Length: 427  
; TYPE: PRT  
; ORGANISM: Homo sapiens  
; SEQ ID NO: 4

Query Match 95.9%; Score 2312; DB 16; Length 427;  
Best Local Similarity 100.0%; Pred. No. 5.8e-170;  
Matches 427; Conservative 0; Nimatches 0; Gaps 0;  
Length: 427  
; TYPE: PRT  
; ORGANISM: Homo sapiens  
; SEQ ID NO: 4

RESULT 10

Qy 439 FDLLKK 445  
Db 421 FDLLKK 427

US-09-905-999-25  
; Sequence 25, Application US/09905999  
; Patent No. US20020106771A1  
; GENERAL INFORMATION:  
; APPLICANT: ULLRICH, Axel  
; APPLICANT: NAYER, Oliver  
; APPLICANT: ULLRICH, Axel  
; LENGTH: 481

Qy 439 FDLLKK 445  
Db 421 FDLLKK 427

US-09-905-999-25  
; Sequence 25, Application US/09905999  
; Patent No. US20020106771A1  
; GENERAL INFORMATION:  
; APPLICANT: ULLRICH, Axel  
; APPLICANT: NAYER, Oliver  
; APPLICANT: ULLRICH, Axel  
; LENGTH: 481

RESULT 11

Qy 439 FDLLKK 445  
Db 421 FDLLKK 427

US-10-267-502-355  
; Sequence 355, Application US/10267502  
; Publication No. US20040071700A1  
; GENERAL INFORMATION:  
; APPLICANT: Kim, Jaeseob  
; APPLICANT: Galant, Ron  
; TITLE OF INVENTION: Obesity Linked Genes  
; FILE REFERENCE: LSD-07416  
; CURRENT APPLICATION NUMBER: US/10/267,502  
; CURRENT FILING DATE: 2003-01-27  
; NUMBER OF SEQ ID NOS: 439  
; SOFTWARE: PatentIn version 3.2  
; SEQ ID NO: 355  
; LENGTH: 481